

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT L. JAFFE

MAILED

Appeal No. 2002-0444
Application No. 09/086,138

OCT 20 2002
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: October 8, 2002

Before WILLIAM F. SMITH, ADAMS and MILLS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 15, all of the claims in the application. Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A method for evaluating a whole effluent sample for the presence of cytotoxic substances comprising the steps of:
 - (a) obtaining a sample for testing suspected of containing a plurality of potentially cytotoxic substances;
 - (b) combining a first aliquot of the whole effluent sample directly with a first culture of a particle-feeding flagellate; and
 - (c) monitoring the growth of the particle-feeding flagellate culture in the presence of the whole effluent sample, wherein a decrease in growth of the culture in

the presence of the whole effluent sample is indicative of the presence of cytotoxic agents in the whole effluent sample.

The reference relied upon by the examiner is:

Jaffe

5,387,508

Feb. 7, 1995

Claims 1 through 15 stand rejected under 35 U.S.C. § 103(a). The examiner relies upon Jaffe as evidence of obviousness. Claims 1 through 15 also stand rejected on obviousness-type double patenting grounds on the basis of the claims of Jaffe. We vacate both rejections and make a new ground of rejection.

DISCUSSION

From a consideration of the issues in this appeal we have concluded that the claims on appeal are indefinite under 35 U.S.C. § 112, second paragraph, for the reasons set forth below. As a result, prior art can only be applied against the claims based upon assumptions or speculation as to the scope of the claims. This is an improper basis to apply prior art. In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). Under these circumstances, it is appropriate to vacate the examiner's rejections in view of the new ground of rejection set forth below.

NEW GROUND OF REJECTION UNDER CFR 1.196(b)

Claims 1 through 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 1 is directed to a method for evaluating a whole effluent sample. To implement this method, claim 1 (a) first requires obtaining a sample, the nature of which is unqualified. On the other hand, claim 1 (b) requires combining a first aliquot of the

whole effluent sample. As presently drafted, it is unclear how many samples must be obtained in claim 1 and how the samples are to be utilized.

Claim 1 is ambiguous to say the least. As set forth in In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), “[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. ... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” Appellant needs to review claim 1 and clarify how many samples are involved in the method and how the samples are to be used.

OTHER ISSUES

If prosecution is resumed in this application and appellant presents claims which obviate the problem set forth in the above rejection, the examiner will have to determine whether the new claims are patentable over the Jaffe reference. In an attempt to move this case forward in a positive manner, we make the following observations.

The key to deciding the patentability issues in this case in our view is the interpretation or construction one places on the phrase “whole effluent sample.” From reviewing the record in this appeal, it appears appellant would have one read this phrase restrictively as if it is qualified by the words “liquid” and “unconcentrated.” To the extent the specification of this application would support such a construction, adoption of that construction without amendment of the claims would be improper. As stated in Intervet Am., Inc. v. Kee-Vet Labs., Inc., 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989), “limitations appearing in the specification will not be read into claims,

and . . . interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'"

Thus, if appellant amends the claims in response to the new ground of rejection, he should take the opportunity to make sure the claim language defines the samples in the manner intended by appellant.

On the other hand, it is unclear how the examiner interprets this phrase. In stating the rejection on pages 5-6 of the Examiner's Answer (Paper No. 22)¹, the examiner did not recognize the inherent ambiguity in claim 1 or favor the record with a statement as to how the phrase "whole effluent sample" is construed. While the examiner points to various disclosures in the Jaffe reference, including Example 6, as apparently describing samples which purportedly meet this claim requirement, until the examiner sets forth how broad or how narrow the claim is being interpreted in this respect, it is not apparent on what basis he believes the various samples described in the reference are encompassed by the claims on appeal.

If prosecution is continued on this subject matter, any further rejection from the examiner should clearly state how the claims are being construed.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

¹ We note that for reasons unclear from the record, the examiner issued a supplemental examiner's answer on August 21, 2001 (Paper No. 24). The supplemental answer appears to be a duplicate of the original answer. In any event, it was not authorized by the rules. See 37 CFR § 1.193(b)(1).

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

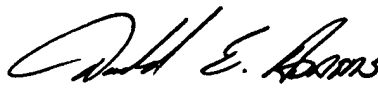
(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

VACATED; 37 CFR § 1.196(b)


William F. Smith
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge


Demetra J. Mills
Administrative Patent Judge

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